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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,937	12/12/2001	Yongcai Wang	83824HEC	1660

7590

08/02/2004

Paul A. Leipold  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

10

<b>Advisory Action</b>	<b>Application No.</b> 10/017,937	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Pamela R. Schwartz	<b>Art Unit</b> 1774	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 14 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: please see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,4-6,8-11 and 13-16.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

  
**PAMELA R. SCHWARTZ**  
**PRIMARY EXAMINER**

Continuation of 2. NOTE: the proposed amendment to the specification has not been entered because it raises the issue of new matter.

Art Unit: 1774

1. Applicants' position is that Kitamura et al. do not disclose the use of stabilizer particles in a base layer. Applicants' assertion to the contrary, Kitamura et al. disclose stabilizer particles may be present in multiple ink receiving layers, the outer ink receiving layer and a lower (or base) ink receiving layer. See [0055] where the reference discloses that the ink receiving layer may be a multi-layered structure and [0033-0034] which disclose the preference for inclusion of an antioxidant and suggests inclusion of antioxidant in one or more ink receiving layers through use of the language "at least one layer... comprises... and ultraviolet ray absorber and an antioxidant." Since this positioning of antioxidant is taught by the reference, it is not "a radically different position" as stated by applicants.

Applicants also argue that they have found surprisingly that inclusion of antioxidant in layer under the image provides significant improvement. However, the reference discloses this arrangement of layers because it is the top ink-receiving layer of the reference that preferably contains dye-fixing cationic compound [0046], and therefore, the image, while all of the ink receiving layers may contain antioxidants. Since treating agents may migrate to the surface of a layer, some beneficial effect of antioxidant in a lower layer would not have been unexpected.

With respect to claim 16, the proposed amendment to the specification has not been entered because it raises the issue of new matter. Applicants are invited to point to support for this limitation in the original specification. The examiner disagrees that applicants' use of "consisting essentially of" successfully

Art Unit: 1774

excludes UV absorbers. The basic and novel characteristic of the invention is its usefulness as an ink jet recording element that provides light fastness to images formed thereon. Inclusion of UV absorber will not materially affect this.

With respect to the Examiner's statement that an improvement of about 50% for color density loss is not unexpected, the Examiner adds the following: the Examiner has studied the examples and tables. The tables in the specification are difficult to decipher because they do not clearly set forth what materials are present in what layers without requiring the reader to refer back and refer back further. However, from the examiner's reading of the specification, Comparative Example 2 contains no stabilizing antioxidant in either the base layer or the image receiving layer. This is the comparative example of Tables 2-3, and since it is well known in the art and expected that inclusion of an antioxidant will improve color density loss to a significant extent, the improved results by inclusion of an antioxidant are not unexpected.

With respect to Table 1, the Comparative Example 1 has antioxidant in the image-receiving layer. The Examiner agrees that a 50% improvement here would have been unexpected. However, applicants' stabilizer particles used in the Examples of the invention have specific compositions and include several components in addition to antioxidant. From page 18, it appears that the antioxidant of SP-1 was already a water insoluble solid, but was combined with polyvinyl alcohol, anionic surfactant, and another ingredient to form stabilizer particles. No reason is given why this was done since particles of the antioxidant alone would have met the claim language. Thus the claims are broader than the

Art Unit: 1774

showings of Table 1 of the specification. Claims commensurate in scope with the showings of Table 1 would be allowable over the art of record.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
July 29, 2004

  
PAMELA R. SCHWARTZ  
PRIMARY EXAMINER